

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : William Shaw
Serial No. : 10/762,816
Filed : January 22, 2004
Title : MEDICAL DEVICES

Art Unit : 3738
Examiner : David J. Isabella
Conf. No. : 6207

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO SPECIES ELECTION REQUIREMENT

Responsive to the action mailed February 8, 2007, applicant elects Species B1. This election encompasses claims 1-6, 7-16, 18, 19-25, 27-33, 35-40, and 51. The election is made *with traverse*. The species requirement is improper for numerous reasons, some of which are given below.

This species requirement is improper because it is not timely. Applicant notes that the Examiner has already issued two substantive non-final office actions, indicating that the Examiner has already conducted a search on the merits of the claims. The MPEP states that:

Election of species may be required prior to a search on the merits (A) in applications containing claims to a plurality of species with no generic claims, and (B) in applications containing both species claims and generic or Marcush claims.

MPEP 808.01(a) (emphasis added). The MPEP also states that “the examiner should make a proper requirement as early as possible in the prosecution, in the first action if possible, otherwise, as soon as need for a proper requirement *develops*.” MPEP 811 (emphasis added). Although 37 CFR 1.142(a) allows for proper restrictions at any stage of prosecution up to final action, the MPEP requires that “[b]efore making a restriction requirement after the first action on the merits, the examiner will consider whether there will be a serious burden if the restriction is not required.” MPEP 811. Given that the Applicant has not significantly amended the claims, it is clear that there would **not** be a serious burden on the Examiner because the Examiner has

already conducted the search on the merits. Moreover, Applicant has not amended the claims in such a way that would raise a new election requirement issue. In the last reply (filed November 6, 2006), Applicant merely added one dependent claim. Therefore, the species requirement is improper and should be withdrawn.

The species requirement also fails to comply with MPEP 809.02(a). The species requirement does not clearly identify each of the “disclosed species, *to which claims are to be restricted.*” MPEP 809.02(a) (emphasis in original). The Examiner does not list figures, examples, or even group claims. Rather the Examiner has made a multi-modal restriction requirement with multiple lists of possible elements. There is no support within the MPEP for this type of species requirement.

For a species requirement to be proper, each species must be mutually exclusive. The various lists of possible elements by the Examiner fail to list mutually exclusive features. For example, the fiber configuration can both have a “continuous length along the entire length of the device,” and be “helically wound about the device.” See Office Action mailed 2/8/2007, page 3, D1 and D2. A polymer-fiber combination could be both layered on a structure, include a polymer matrix and fiber reinforcement, and have polymer and fiber on a tubular structure. See Office Action mailed 2/8/2007, page 2, C1, C2, and C4. Furthermore, a non-ceramic fiber can be made out of a plastic material. See e.g., specification, page 10, lines 5-6. Although the Examiner does include a few examples of possibly mutually exclusive features, the Examiner has not indicated how all of the elements are each mutually exclusive. Moreover, as shown in the discussion above, many of the listed elements are not mutually exclusive. Furthermore, the Examiner is reminded that the claims include “comprising” rather than “consisting” type language; thus the restrictions are improper because the claims do not exclude the possibility of the inclusion of additional elements. Furthermore, Applicant notes that this election of a particular species does not impact the meaning or scope of any currently pending claim in any manner.

For the above reasons, the species requirement is improper and must be withdrawn. In an attempt to resolve this issue, the undersigned telephoned the Examiner three times between February 15 and 16, 2007, but was unable to reach the Examiner. In light of the record,

Applicant : William Shaw
Serial No. : 10/762,816
Filed : January 22, 2004
Page : 3 of 3

Attorney's Docket No.: 10527-455001 / 02-312

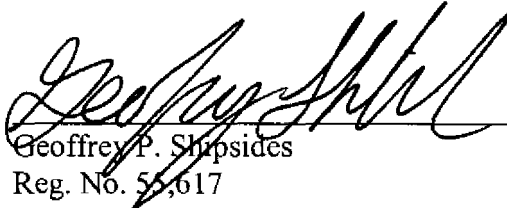
Applicant respectfully requests the prompt allowance of the pending claims, as they have already been examined and there is no currently outstanding rejection of any claim.

Applicant requests for the Examiner to contact the undersigned by telephone if there are any further issues.

Please apply any charges or credits to deposit account 06 1050.

Respectfully submitted,

Date: 2/20/2007


Geoffrey P. Shippides
Reg. No. 55,617

Fish & Richardson P.C.
60 South Sixth Street, Suite 3300
Minneapolis, MN 55402
Telephone: (612) 335-5070
Facsimile: (612) 288-9696